



Practitioner's Docket No. 1118/192

*ifw*  
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re application of: Hunter

Application No.: 10/796,856

Group No.: 1743

Filed: March 9, 2004

For: Method and Apparatus for Performing Microassays

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL OF SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT  
WITHIN THREE MONTHS OF FILING OR  
BEFORE MAILING OF FIRST OFFICE ACTION (37 C.F.R. § 1.97(b))

IDENTIFICATION OF TIME OF FILING THE ACCOMPANYING  
INFORMATION DISCLOSURE STATEMENT

The information disclosure statement submitted herewith is being filed within three months of the filing date of the application or date of entry into the national stage of an international application or before the mailing date of a first Office action on the merits, whichever event occurs last. 37 C.F.R. § 1.97(b).

---

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\*  
(When using Express Mail, the Express Mail label number is *mandatory*;  
*Express Mail certification is optional*.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

37 C.F.R. § 1.8(a)

with sufficient postage as first class mail.

37 C.F.R. § 1.10\*

as "Express Mail Post Office to Addressee"  
Mailing Label No. \_\_\_\_\_ (*mandatory*)

TRANSMISSION

facsimile transmitted to the Patent and Trademark Office, (703) \_\_\_\_\_.

  
Signature

Date: June 16, 2005

Samuel J. Petuchowski  
(type or print name of person certifying)

\* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(j). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

DATE: June 16, 2005



**Samuel J. Petuchowski**  
BROMBERG & SUNSTEIN LLP  
Customer Number 02101  
125 Summer Street  
Boston, MA 02110-1618  
US

01118/00192 393479.1

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent application

Inventor(s)

Title of invention



the specification of which is being transmitted herewith

OR

In re application of: Hunter

Application No.: 10/796,856

Group No.: 1743

Filed: March 9, 2004

Examiner: N/A

For: Method and Apparatus for Performing Microassays

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

## SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

(Supplemental Information Disclosure Statement--page 1 of 8)

## CERTIFICATION UNDER 37 C.F.R. SECTIONS 1.8(a) and 1.10\*

(When using Express Mail, the Express Mail label number is mandatory;  
 Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

## MAILING

deposited with the United States Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA  
 22313-1450

37 C.F.R. SECTION 1.8(a)

37 C.F.R. SECTION 1.10\*

 with sufficient postage as first class mail.

as "Express Mail Post Office to Addressee"  
 Mailing Label No. \_\_\_\_\_ (mandatory)

## TRANSMISSION

 transmitted by facsimile to the Patent and Trademark Office.

Signature

Samuel J. Petuchowski

(type or print name of person certifying)

Date: June 16, 2005

\*WARNING: Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. section 1.10(b).

"Since the filing of correspondence under section 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable C.F.R.e, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

**NOTE:** "An information disclosure statement shall be considered by the Office if filed by the applicant:

- (1) Within three months of the filing date of a national application;
- (2) Within three months of the date of entry of the national stage as set forth in section 1.491 in an international application; or
- (3) Before the mailing date of a first Office action on the merits, whichever event occurs last." 37 C.F.R. section 1.97(b).

**NOTE:** "Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith

in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section." 37 C.F.R. section 1.56(a).

"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) each inventor named in the application;
- (2) each attorney or agent who prepares or prosecutes the application; and
- (3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. section 1.56(c).

**NOTE:** The "duty as described in section 1.56 will be met so long as the information in question was cited by the Office or submitted to the Office in the manner prescribed by sections 1.97(b) - (d) and 1.98 before issuance of the patent." Notice of January 9, 1992, 1135 O.G. 13-25 at 17.

**WARNING:** "No information disclosure statement may be filed in a provisional application." 37 C.F.R. section 1.51(b).

### **List of Sections Forming Part of This Information Disclosure Statement**

The following sections are being submitted for this Information Disclosure Statement:

*(check sections forming a part of this statement: discard unused sections and number pages consecutively)*

1. Preliminary Statements
2. Forms PTO/SB/08A and 08B (substitute for Form PTO-1449)
3. Statement as to Information Not Found in Patents or Publications
4. Identification of Prior Application in Which Listed Information Was Already Cited and for Which No Copies Are Submitted or Need Be Submitted
5. Cumulative Patents or Publications
6. Copies of Listed Information Items Accompanying This Statement
7. Concise Explanation of Non-English Language Listed Information Items
  - 7A. EPO Search Report
  - 7B. English Language Version of EPO Search Report
8. Translation(s) of Non-English Language Documents
9. Concise Explanation of English Language Listed Information Items (Optional)
10. Identification of Person(s) Making This Information Disclosure Statement

*(complete the following, if appropriate)*

Sections , respectively, have been continued on ADDED PAGE(S).

**NOTE :**"Once the minimum requirements are met, the examiner has an obligation to consider the information." Notice of April 20, 1992 (1138 O.G. 37-41, 37).

## **Section 1. Preliminary statements**

Applicants submit herewith patents, publications or other information, of which they are aware that they believe may be material to the examination of this application, and in respect of which, there may be a duty to disclose.

The filing of this information disclosure statement shall not be construed as a representation that a search has been made (37 C.F.R. section 1.97(g)), an admission that the information cited is, or is considered to be, material to patentability, or that no other material information exists.

The filing of this information disclosure statement shall not be construed as an admission against interest in any manner. Notice of January 9, 1992, 1135 O.G. 13-25, at 25.

**SECTION 2. FORMS PTO/SB/08A and 08B (formerly Form PTO-1449)**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**



Applicants: Ian Hunter Attorney Docket: 1118/192  
 Serial No: 10/796,856 Art Group Unit: 1743  
 Date Filed: March 9, 2004 Examiner Name: N/A  
 Invention: Method and Apparatus for Performing Microassays

**LIST OF PATENTS AND PUBLICATIONS FOR  
 APPLICANT'S SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

U.S. PATENT DOCUMENTS					
Examiner Initials	Reference Number	Document Number	Issue Date/ Publication Date	Inventor	Class/Subclass
	<b>BH</b>	US 2,771,398	11/1956	Snyder	
	<b>BI</b>	US 4,415,732	11/15/1983	Caruthers et al.	
	<b>BJ</b>	US 4,458,066	07/03/1984	Caruthers et al.	
	<b>BK</b>	US 4,500,707	02/19/1985	Caruthers et al.	
	<b>BL</b>	US 4,861,448	08/29/1989	Cantor et al.	
	<b>BM</b>	US 4,973,679	11/27/1990	Caruthers et al.	
	<b>BN</b>	US 5,153,319	10/06/1992	Caruthers et al.	
	<b>BO</b>	US 5,215,593	06/01/1993	Nojo et al.	
	<b>BP</b>	US 5,284,753	02/08/1994	Goodwin, Jr.	
	<b>BQ</b>	US 5,374,525	12/1994	Lalouel et al.	
	<b>BR</b>	US 5,445,934	08/29/1995	Fodor et al.	
	<b>BS</b>	US 5,510,270	04/23/1996	Fodor et al.	
	<b>BT</b>	US 5,599,664	02/04/1997	Schwartz	
	<b>BU</b>	US 5,605,662	02/25/1997	Heller et al.	
	<b>BV</b>	US 5,621,094	04/1997	Roser et al.	
	<b>BW</b>	US 5,632,957	05/27/1997	Heller et al.	
	<b>BX</b>	US 5,744,101	04/28/1998	Fodor et al.	
	<b>BY</b>	US 5,773,238	06/30/1998	Shukla	
	<b>BZ</b>	US 5,795,748	08/18/1998	Cottingham	
	<b>CA</b>	US 5,807,522	09/15/1998	Brown et al.	
	<b>CB</b>	US 5,840,862	11/24/1998	Bensimon et al.	
	<b>CC</b>	US 5,856,100	01/05/1999	Hayashizaki	
	<b>CD</b>	US 5,888,723	03/30/1999	Sutton et al.	
	<b>CE</b>	US 5,922,604	07/13/1999	Stapleton et al.	
	<b>CF</b>	US 5,929,208	07/27/1999	Heller et al.	
	<b>CG</b>	US 5,944,652	08/1999	Miller et al.	
	<b>CH</b>	US 5,955,377	09/21/1999	Maul et al.	
	<b>CI</b>	US 5,958,345	09/28/1999	Turner et al.	

	<b>CJ</b>	US 6,004,744	12/21/1999	Goelet et al.	
	<b>CK</b>	US 6,060,240	05/2000	Kamb et al.	
	<b>CL</b>	US 6,071,702	06/2000	Yamamoto et al.	
	<b>CM</b>	US 6,147,198	11/14/2000	Schwartz	
	<b>CN</b>	US 6,309,600	10/30/2001	Hunter	
	<b>CO</b>	US 6,436,632	08/20/2002	Schellenberger et al.	
	<b>CP</b>	US 6,565,813	05/2003	Garyantes, Tina	
	<b>CQ</b>	US 6,713,309	03/2004	Anderson et al.	
	<b>CR</b>	US 2002-0001546	01/03/2002	Hunter et al.	
	<b>CS</b>	US 2003-0124716	07/03/2003	Hess et al.	

FOREIGN PATENT DOCUMENTS						
Examiner Initials	Reference Number	Country Code	Document Number	Publication Date	Patentee or Applicant	Class/Subclass
	<b>CT</b>	WO	98/45406	10/15/1998		
	<b>CU</b>	WO	98/47003	10/22/1998		
	<b>CV</b>	WO	99/11373	03/11/1999		
	<b>CW</b>	WO	99/19510	04/22/1999		
	<b>CX</b>	WO	99/34920	07/15/1999		
	<b>CY</b>	WO	99/47922	09/23/1999		
	<b>CZ</b>	WO	99/52560	10/21/1999		
	<b>DA</b>	WO	00/56456	09/28/2000		
	<b>DB</b>	WO	02/87764	11/07/2002		
	<b>DC</b>	WO	02/30561	04/18/2002		
	<b>DD</b>	WO	03/02226	01/09/2003		
	<b>DE</b>	WO	99/39829	08/1999		

OTHER DOCUMENTS			
Examiner Initials	Reference Number	Author	Title of Article, Title of Journal, Volume Number, Page Numbers, Date
	<b>DF</b>	Wittwer et al.	“The Light Cycler: A Microvolume Multisample Fluorimeter with Rapid Temperature Control”, pp. 176-181, BioTechniques, January 1997.
	<b>DG</b>		“Current Protocols in Molecular Biology”, Vol. 1, John Wiley & Sons, Inc., 1995.
	<b>DH</b>		“Mapping Genomes”, Vol. 4, Cold Spring Harbor Laboratory Press, 1999.
	<b>DI</b>	Erfle et al.	“Simultaneous loading of 200 sample lanes for DNA sequencing on vertical and horizontal, standard and ultrathin gels”, Vol. 25, No. 11, pp. 2229-2230, Oxford University Press, 1997.
	<b>DJ</b>	MacBeath et al.	“Printing Proteins as Microarrays for High-Throughput Function Determination”, pp. 1760-1762, Vol. 289, Science, September 2000.

	<b>DK</b>	Sambrook et al.	<i>"Molecular Cloning"</i> , 2nd Edition, Cold Spring Harbor Laboratory Press, 1989.
	<b>DL</b>	Singh-Gasson et al.	<i>"Maskless fabrication of light-directed oligonucleotide microarrays using a digital micromirror array"</i> Vol. 17, pp. 974-978, Nature Biotechnology, October 1999.
	<b>DM</b>	Vogelstein et al.	<i>"Digital PCR"</i> Vol. 96, pp. 9236-9241, Proc. Natl. Acad. Sci USA, August 1999.
	<b>DN</b>	Smith et al.	<i>"Dynamical Scaling of DNA Diffusion Coefficients"</i> , Vol. 29, pp. 1372-1373, Macromolecules, 1996.
	<b>DO</b>	Thorstenson et al.	<i>"Global Analysis of ATM Polymorphism Reveals Significant Functional Constraint"</i> , Vol. 69, pp. 396-412, Am. J. Hum. Genet., 2001.
	<b>DP</b>	Wittwer et al.	<i>"Continuous Fluorescence Monitoring of Rapid Cycle DNA Amplification"</i> , Vol. 22, pp. 130-138, BioTechniques, January 1997.
	<b>DQ</b>		<i>"Oligonucleotide synthesis: A Practical Approach"</i> : IRL Press.
	<b>DR</b>		<i>"Oligonucleotides and Analogues: A Practical Approach"</i> , Oxford University Press, 1991.
	<b>DS</b>	Maniatis et al.	<i>"Molecular Cloning"</i> , Cold Spring Harbor Laboratory, 1982.

Examiner Signature: \_\_\_\_\_

Date Considered: \_\_\_\_\_

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation *if not* in conformance and not considered. Include copy of this form with next communication to applicant.

## Section 6. Copies of Listed Information Items Accompanying This Statement

**NOTE:** *37 C.F.R. section 1.98(a)(2) requires that any information disclosure statement filed under section 1.97 shall include: "A legible copy of: (i) Each U.S. and foreign patent; (ii) Each publication or that portion which caused it to be listed; and (iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included..."*

**NOTE:** *The wording in section 1.98(a)(2)(iii) makes it clear that the requirement to submit a copy of each item of information listed in an information disclosure statement does not apply to the citation of a U.S. patent application. Notice of January 9, 1992, 1135 O.G. 13-25, at 14.*

Legible copies of all items listed in Forms PTO/SB/08A and 08B (substitute for Form PTO-1449) accompany this information statement.

*(complete the following, if applicable)*

Exception(s) to above:

Items in prior application, from which an earlier filing date is claimed for this application, as identified in Section 4.

Cumulative patents or publications identified in Section 5.

**U.S. patent citations are not included pursuant to the United State Patent and Trademarks Office's September 21, 2004 waiver of the copy requirement in 37 CFR 1.98 for cited pending U.S. patent citations when the patent citations are available in the USPTO's IFW system.**

**Section 10. Identification of Person(s) Making This Information Disclosure Statement**

The person making this certification is

*(check each applicable item)*

(a)  the inventor(s) who signs below

---

**SIGNATURE OF INVENTOR**

*(type name of inventor who is signing)*

(b)  an individual associated with the filing and prosecution of this application (37 C.F.R. section 1.56(c))

---

**SIGNATURE OF INVENTOR**

*(type name of inventor who is signing)*

(c)  the practitioner who signs below on the basis of the information:

*(check each applicable item)*

supplied by the inventor(s).

supplied by an individual associated with the filing and prosecution of this application. (37 C.F.R. section 1.56(c)).

in the practitioner's file.

---

**SIGNATURE OF PRACTITIONER**

Samuel J. Petuchowski

*(type or print name of practitioner)*

Bromberg & Sunstein LLP

125 Summer Street, 11<sup>th</sup> Floor

P.O. Address

Boston, MA 02110

Reg. No.: 37,910

Tel. No.: (617) 443-9292

Customer No.: 002101

01118/00192 393412.1